

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-4, 6-12, 14-18, and 20-23 are currently pending. Claims 1, 9, and 15 have been amended by the present amendment. The changes to the claims are supported by the originally filed specification and do not add new matter.

In the outstanding Office Action, Claims 1, 9, and 15 were rejected under 35 U.S.C. § 112, second paragraph, regarding the “second formatting account information” and the “appears identical” limitations; and Claims 1-4, 6-12, 14-18, and 20-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,249,770 to Erwin et al. (hereinafter “the ‘770 patent”) in view of U.S. Patent No. 5,608,874 to Ogawa et al. (hereinafter “the ‘874 patent”) and U.S. Patent No. 5,848,413 to Wolff (hereinafter “the ‘413 patent”).

Regarding the rejection of Claims 1, 9, and 15 under 35 U.S.C. § 112, second paragraph, regarding the second formatted account information, Applicants note that pages 7 and 8 of the specification describe how second formatted account information is stored in a storage area, without storing graphical images of an original printed account statement. See also, e.g., Figures 2A-2C. Accordingly, Applicants respectfully traverse the rejection of Claims 1, 9, and 15 under 35 U.S.C. § 112, regarding the “second formatted account information” limitation.

Further, Applicants respectfully submit that the rejection of Claims 1, 9, and 15 under 35 U.S.C. § 112, second paragraph, regarding the “appears identical” limitation is rendered moot by the present amendment to Claims 1, 9, and 15. Claims 1, 9, and 15 have been amended to delete the phrase “appears identical in all material aspects”. Accordingly, this rejection of the claims is believed to have been overcome.

Amended Claim 1 is directed to a method, comprising: (1) formatting first formatted account information into second formatted account information; (2) storing the second formatted account information in a storage area, without storing graphical images of an original printed account statement; (3) interactively inputting a request for the second formatted account information; and (4) transferring the second formatted account information from the storage area to a display device for displaying the second formatted account information in a format that is identical to the original printed account statement. Further, Claim 1 clarifies that the first formatted account information comprises formatted information for the original printed account statement; the second formatted account information is formatted in HTML; and the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement. The changes to the claims are supported by the originally filed specification and do not add new matter.

Regarding the rejection of Claim 1 under 35 U.S.C. § 103(a), the Office Action asserts that the '770 and '874 patents disclose everything in Claim 1 with the exception that "the second formatted account information is formatted in HTML; and the transferring step includes superimposing said second formatted account information on a background image corresponding to a background of the original printed account statement,"² and relies on the '413 patent to remedy those deficiencies.

The '770 patent is directed to a method and system for automatically analyzing historical financial statements and generating financial forecasts. However, as admitted in the Office Action, the '770 patent fails to disclose formatting first formatted account information into second formatted account information, or transferring a second formatted account information from a storage area to a display device, for displaying the second

² Outstanding Office Action, page 4, second paragraph.

formatted account information. Further, as admitted in the Office Action, the '770 patent fails to disclose that the second formatted account information is formatted in HTML, and that the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1.

The '874 patent is directed to a system and method for automatic data file format translation. The '874 patent discloses receiving data from a wide variety of remote sources, identifying the format of the data, translating the data into a common file format, and then converting the data to a specific format needed for a particular recipient. However, as admitted in the Office Action, the '874 patent fails to disclose that the second formatted account information is formatted in HTML, and that the transferring step includes superimposing the second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1.

The '413 patent is directed to a document retrieval and accessing system in which documents are provided with links to other documents and selection of one or more of the links causes the corresponding documents to be retrieved and sent to the requesting party. As shown in Figure 4, the '413 patent discloses that a gateway machine 102 receives a fax from a user, such as the fax shown in Figure 3, wherein a link has been circled by the user. As shown in Figure 5, the gateway machine first extracts the circled regions from the received fax image to obtain machine readable information, decodes the information obtained, and determines the identifier/locator based on the decoded information. As shown in Figure 4, the '413 patent discloses that the desired documents are retrieved and an image is created of each of the retrieved documents, which are then sent by facsimile transmission to the user. Regarding step 404 in Figure 4, the '413 patent discloses that

...gateway 102 creates images by parsing, formatting and rendering the documents. The parsing of the documents, as well as formatting and rendering of the parsed documents, includes the conversion of document identifiers/locators associated with the retrieved documents to a machine readable code (e.g., barcode, digital paper, etc.) to be included in the images faxed to the user (to enable user selection of additional documents). Rendering is necessary for most documents to convert the data from ASCII to a raster bit map, the protocol used by fax machines (and other marking engines).³

However, Applicants respectfully submit that the '413 patent fails to disclose a step of transferring second formatted account information from a storage area to a display device for displaying the second formatted account information including superimposing the second formatted account information on the background image corresponding to a background of the original printed account statement, as recited in Claim 1. Rather, the '413 patent merely discloses that a user faxes a document in which hyperlinks have been circled to a gateway machine which retrieves the circled documents and creates an image to be faxed back to the user. The '413 patent is silent regarding a background image corresponding to a background of an original printed account statement, as recited in Claim 1. In this regard, Applicants note that a word search of the '413 patent indicates that the '413 patent fails to contain the word "superimposing" or the word "background". Moreover, Applicants note that the outstanding Office Action fails to specifically identify how the '413 patent discloses this limitation. Rather, the outstanding Office Action merely discusses the '413 patent in general terms and refers Applicant to columns 2-5 of the '413 patent.⁴

Thus, no matter how the teachings of the '770, '874, and '413 patents are combined, the combination does not teach or suggest a transferring step that includes superimposing a second formatted account information on a background image corresponding to a background of the original printed account statement, as recited in Claim 1. In particular, Applicants

³ '413 patent, column 6, lines 40-50.

⁴ See pages 4 and 5 of the outstanding Office Action.

respectfully submit that none of the cited references discloses a relationship between a printed account statement and the displaying of an image that corresponds to a printed account statement, as required by Claim 1. Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejection of Claim 1 (and dependent Claims 2-4, 6-8, and 21) should be withdrawn.

In the outstanding Office Action, the stated motivation for combining the teachings of the '770, '874, and '413 patent is "in order to transfer an HTML document information, on a background image."⁵ However, Applicants respectfully submit that the Examiner is merely stating perceived advantages of Applicants' invention, without identifying that without Applicants' specification, one of ordinary skill in the art would have even thought to address the problem. Such hindsight reconstruction of Applicants' invention can not be used to establish a *prima facie* case of obviousness.

Independent Claims 9 and 15 recite limitations analogous to the limitations recited in Claim 1. Accordingly, for the reasons stated above for the patentability of Claim 1, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that the rejections of Claims 9 and 15 (and all associated dependent claims) should be withdrawn.

Dependent Claims 21, which depends from Claim 1, recites that the background image includes at least one of a watermark image, a letterhead image, and a screened image. Claims 22 and 23, which depend from Claims 9 and 15, respectively, recite analogous limitations.

Applicants note that the outstanding Office Action fails to specifically address dependent Claim 21. However, the Office Action does address Claims 22 and 23 on page 13 of the outstanding Office Action. Regarding Claim 22, the Office Action states that "Erwin

⁵ See page 5 of the outstanding Office Action.

discloses wherein said background image includes at least one of a watermark image, a letterhead image, and a screened image. (See column 5, lines 55-65 and column 6, line 5).” However, Applicants note that an examination of columns 5 and 6 of the ‘770 patent indicates that the passage cited by the Examiner refers to ‘770 Figure 4, which relates to the generation of spreadsheets and financial forecasts for a company, and has nothing to do with watermarks. Moreover, Applicants note that the Examiner’s rejection of Claim 1 specifically states that Erwin does not disclose that the transferring step includes superimposing second formatted account information on the background image corresponding to a background of the original printed account statement. Accordingly, Applicants fail to see how the Examiner could also assert that the ‘770 patent does disclose a background image that includes at least one of a watermark image, a letterhead image, and a screened image, as recited in Claim 21.

Moreover, regarding Claim 23, which recites the same limitation as Claims 21 and 22, the Office Action on page 13 asserts that “Erwin and Ogawa fail to explicitly teach wherein said background image includes at least one of a watermark image, a letterhead image, and a screen image. (See column 5, lines 55-65 and column 6, line 5).” Accordingly, Applicants request clarification of the rejection of Claims 21-23 since the rejection of Claim 23 is inconsistent with the rejection of Claim 22, since the rejection of Claim 23 on page 13 states that the combination of the ‘770 and ‘874 patents fails to disclose the limitation recited in Claim 23, but does not proceed to indicate on what basis that claim is rejected.

Thus, it is respectfully submitted that independent Claims 1, 9, and 15 (and all associated dependent claims) patentably define over any proper combination of the ‘770, ‘874, and ‘413 patents.

Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

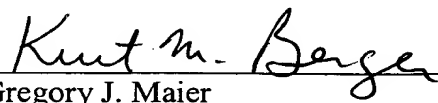
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